

## **REMARKS**

The Examiner is thanked for the thorough review and examination of this application. The Office Action, however, has continued to reject all pending claims 1-3, 6-10, and 14-20.

### **Objection to the Drawings and Amendment to the specification**

The Office Action objected to the drawings as allegedly failing to show the claimed “third electronic element...” In response, Applicant notes that the third electronic element is, in fact, shown in Fig. 4 (the electronic element 340, which was inadvertently referred to the second electronic element). Applicant has amended the specification herein to correct this inadvertent reference. Also, the electronic element 541 shown in Fig. 6 is referred to the third electronic element. With the clarifying amendment to the specification, the objection to the drawings is overcome and should be withdrawn.

### **Amendment of claims**

Claim 1 is amended herein to add the features of: “the spring element is substantially U-shaped” and “the spring leg is substantially linear”. These features clear define claim 1 over the cited art.

### **Rejection according to 35 USC 103**

Turning now to the substantive rejections, claims 1-3, 6-10 and 14-20 were rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Koichi et al (JP/2002-006754) in view of Daszkowski et al. (US 4,689,720)

Regarding independent claim 1, this claim has been amended and defines the spring element to be *U-shaped* and the *spring leg to be linear*. In contrast, Daszkowski teaches a spring element that is not U-shaped and the spring leg (18', 20', 32) is S-shaped (rather than linear – as claimed). For at least this reason, the structure expressly recited in claim 1 is different from that of Daszkowski.

This structure is relevant to proper operation because, as the spring element is U-shaped and the linear spring leg extends toward the back cover, the spring leg deforms to stretch out to fit the distance between the back cover and the electronic element on which the spring element is disposed. As the spring leg (18', 20', 32) in Daszkowski is S-shaped, when the distance between the back cover and the electronic element is shortened, the spring element is easily inclined, which may cause inclination of the back cover, as shown in Figs. 3C and 3D. The U-shaped spring element in claim 1 can uniformly deform. As a result, no inclination happens.

As the combination of Koichi and Daszkowski (even if properly combined) does not include all features in claim 1, the rejection should be withdrawn. The rejections of claims 2-3, 6-10 and 14-20 should be withdrawn by virtue of their dependency from claim 1.

As a separate and independent basis for the patentability of all claims, Applicant respectfully traverses the rejections as failing to identify a proper basis for combining the cited references. In combining these references, the Office Action stated only that the combination would have been obvious for “enhancing the overall efficiency of the cooling arrangement of the display of Koichi.” (Office Action, page 4). This alleged motivation is clearly improper in view of well-established Federal Circuit precedent.

It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

*(Emphasis added.)* In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to derive a plasma display, as claimed by the Applicant.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination").

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be “clear and particular.” Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 (“The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000). The rationales relied on by the Office Action in the present application are merely generic statements, that have nothing to do specifically with the structures disclosed in the other references. As such, these rationales cannot be properly viewed as proper motivations for combining the specific teachings of the individual references. Indeed, the generic motivations advanced by the present Office Action could be used to support a combination of ANY references, which is clearly contra to the cited Federal Circuit precedent and the clear intent of 35 U.S.C. § 103.

For at least the additional reason that the Office Action failed to identify proper motivations or suggestions for combining the various references to properly support the rejections under 35 U.S.C. § 103, those rejections should be withdrawn.

### CONCLUSION

For at least the reasons described above, all claims are now in condition for allowance.

Should Examiner feel that further discussion of the application and the Amendment is conducive to prosecution and allowance thereof, please do not hesitate to contact the undersigned at the address and telephone listed below.

No fee is believed to be due in connection with this Amendment and Response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

By:   
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